

## **REMARKS**

### **I. Summary of Amendment**

By this Amendment, Applicant has amended claims 1-3, 17-19, 22, 24-26, 36-38, 52-54, 57, 59-61, 68, and 74, added claims 92-97, and cancelled claims 86-91, without prejudice or disclaimer.

### **II. Summary of Office Action**

In the Office Action<sup>1</sup>, the Office:

- (a) rejected claims 1-91 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter;
- (b) rejected claims 2-6 under 35 U.S.C. § 112, ¶ 2, as being indefinite;
- (c) rejected claims 1-18 and 20-26 under 35 U.S.C. § 102(b) over U.S. Pat. Appl. Pub. No. 2002/0035486 A1 ("*Huyn*");
- (d) rejected claims 19 and 27-35 under 35 U.S.C. § 103(a) over *Huyn* in view of U.S. Pat. Appl. Pub. No. 2002/0022973 A1 ("*Sun*"); and
- (e) rejected claims 36-91 "for the same reasons as above." Office Action at 10.

### **III. Rejection under 35 U.S.C. § 101**

The Office rejected claims 1-91 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

The USPTO recently issued Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101 ("Interim Instructions"). The Interim Instructions provide a two part test for process claims - (i) the claimed process must be tied to a particular machine or apparatus (machine implemented) or (ii) the claimed

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<sup>1</sup> Applicant notes that the Office Action contains numerous statements concerning the related art, claims, etc. Regardless of whether any such statement is addressed specifically herein, Applicant declines to automatically subscribe to any assertion or characterization in the Office Action.

process must particularly transform a particular article to a different state or thing. The Interim Instructions also indicate that “[f]or computer implemented processes, the ‘machine’ is often disclosed as a general purpose computer. In these cases, the general purpose computer may be sufficiently ‘particular’ when programmed to perform the process steps.” Interim Instructions at 6.

Amended independent claims 1, 36, and 68 recite methods that are “executed by a computer system.” Therefore, amended independent claims 1, 36, and 68, and their dependent claims 2-35, 37-67, and 69-85,<sup>2</sup> are directed to statutory subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 1-85 under 35 U.S.C. § 101.

#### **IV. Rejection under 35 U.S.C. § 112, ¶ 2**

The Office rejected claims 2-6 under 35 U.S.C. § 112, ¶ 2, as being indefinite. Specifically, the Office alleged that “[i]n claims 2-6, which are dependent on claim 1, the application shows that both multivariate analysis and tree segmentation had to be taught which is contrary to limitations in claim 1.” Office Action at 4. Amended claim 2 depends from claim 1 and recites that “the diagnostic algorithm is generated using at least the multivariate analysis.” Thus, amended claim 2 further limits claim 1 to a method, “wherein the diagnostic algorithm is generated using at least the multivariate analysis.” Accordingly, the limitations of amended claim 2 are not contrary to the limitations of claim 1. Therefore, amended claim 2 is definite. Further, although amended claim 3, and original claims 4-6 have different scopes than amended claim 2,

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<sup>2</sup> Applicant has cancelled dependent claims 86-91. Accordingly, the rejection of dependent claims 86-91 under 35 U.S.C. § 101 is moot.

they are definite for at least similar reasons as amended claim 2. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 2-6 under 35 U.S.C.

§ 112, ¶ 2.

#### **V. Rejection under 35 U.S.C. § 102(b)**

The Office rejected claims 1-18 and 20-26 under 35 U.S.C. § 102(b) over *Huyn*.<sup>3</sup> To anticipate a claim, a reference must disclose either expressly or inherently each and every element of the claim. See M.P.E.P. § 2131. Amended independent claim 1 recites, among other things, “selecting, via [a] computer system, a second question according to the first information and according to a diagnostic algorithm generated using at least one of a multivariate analysis and a tree segmentation technique.”

Since the Office alleged that Figure 6 of *Huyn* purportedly teaches “a tree segmentation technique,” Office Action at 5, Applicant assumes that the Office is interpreting Figure 9b of *Huyn* to be “a diagnostic algorithm.”<sup>4</sup> Figure 6 is “a schematic diagram of a questionnaire,” *Huyn*, ¶ [0022], and Figure 9b is “flow diagram[] of a questionnaire method.” *Huyn*, ¶ [0026]. Figure 9b’s flow diagram of the questionnaire method is not generated using Figure 6’s schematic diagram of the questionnaire. Therefore, even if (1) the schematic diagram of Figure 6 were to disclose “a tree segmentation technique,” which Applicant does not concede, and (2) the flow diagram of Figure 9b were to be “a diagnostic algorithm,” which Applicant also does not

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<sup>3</sup> The present application claims the benefit of priority of U.S. Provisional Patent Application No. 60/387,918, which was filed on June 13, 2002. *Huyn* was published on March 21, 2002. Since *Huyn* was published less than one year prior to the priority date of the present application, *Huyn* is not available as a § 102(b) reference. Moreover, even if *Huyn* was available as a reference, it does not teach each and every element of claims 1-18 and 20-26, as discussed below.

<sup>4</sup> Applicant requests that the Office either confirm that Applicant’s assumption is correct or clarify its rejection of claim 1.

concede, *Huyn* still does not teach “a diagnostic algorithm generated using at least one of a multivariate analysis and a tree segmentation technique,” as recited in amended independent claim 1. Accordingly, *Huyn* fails to teach each and every element of amended independent claim 1.

For at least these reasons, the rejection of claim 1 under 35 U.S.C. § 102(b) over *Huyn* should be withdrawn. Additionally, the rejection of dependent claims 2-18 and 20-26 under 35 U.S.C. § 102(b) over *Huyn* should be withdrawn at least because of their dependence from amended independent claim 1.

Moreover, in addition to the above-discussed features of claim 1, at least, for example, dependent claims 2-6 include additional features that are neither expressly nor inherently disclosed by *Huyn*. For example, claim 2 recites, among other things, that “the multivariate analysis includes at least one of a principal component analysis, a factorial analysis, PLS path modeling, and structural equation modeling,” none of which are disclosed by *Huyn*. Further, claim 3 recites, among other things, that “the tree segmentation technique includes a classification and regression tree method,” which is not disclosed by *Huyn*. And, claim 4 recites, among other things, that “the classification and regression tree method is at least one of a CART method, a CHAID method, and a QUEST method,” none of which are disclosed by *Huyn*. In addition, claim 5 recites, among other things, that the diagnostic algorithm is “generated using at least both the multivariate analysis and the tree segmentation technique,” a combination which is not disclosed by *Huyn*. And, claim 6 recites, among other things, that “the multivariate analysis includes a principal component analysis,” which is not disclosed by *Huyn*, and that “the tree segmentation technique includes a classification and regression tree

method,” which is also not disclosed by *Huyn*. Accordingly, for at least these additional reasons, the rejection of dependent claims 2-6 under 35 U.S.C. § 102(b) over *Huyn* should be withdrawn.

#### **VI. Rejection under 35 U.S.C. § 103(a)**

The Office rejected claims 19 and 27-35 under 35 U.S.C. 103(a) over *Huyn* in view of *Sun*. This rejection should be withdrawn because there is no prima facie case of obviousness. Claims 19 and 27-35 depend from amended independent claim 1. As discussed above, *Huyn* fails to teach each and every element of amended independent claim 1. *Sun*, separately or in combination with *Huyn*, fails to cure the above-discussed deficiencies of *Huyn*. Accordingly, the rejection of claims 19 and 27-35 under 35 U.S.C. § 103(a) over *Huyn* in view of *Sun* should be withdrawn.

#### **VII. Rejection of Claims 36-91**

The Office alleged that claims 36-91 recite the same claim limitations as claims 1-35, and rejected claims 36-91 “for the same reasons as above.” Office Action at 10. This rejection should be withdrawn because the Office Action fails to set forth a prima facie case of anticipation under 35 U.S.C. § 102 or obviousness under 35 U.S.C. § 103(a). As is apparent from a review of claims 36-85,<sup>5</sup> they do not recite the same features as claims 1-35. Further, the Office Action fails to provide any meaningful explanation of the statutory basis for the rejection of claims 36-85 (e.g., an express reference to a section of 35 U.S.C., such as § 102(b) or § 103(a).). See M.P.E.P. § 707.07(d). Moreover, to the extent any of claims 36-85 is rejected based on *Huyn*

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<sup>5</sup> Applicant has cancelled dependent claims 86-91. Accordingly, the rejection of dependent claims 86-91 “for the same reasons as above” is moot.

and/or *Sun*, the Office Action lacks any explanation of the pertinence of *Huyn* and/or *Sun* with respect to claims 36-85. See 37 C.F.R. § 1.104(c)(2). Since no prima facie case of anticipation under 35 U.S.C. § 102 or obviousness under 35 U.S.C. § 103(a) has been made, the rejection of claims 36-85 should be withdrawn.

**CONCLUSION**

Applicant requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 21, 2009

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